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FULWIDER PATTON LEE & UTECHT, LLP  
200 OCEANGATE, SUITE 1550  
LONG BEACH, CA 90802

EXAMINER

TRAN A, PHI DIEU N

ART UNIT PAPER NUMBER

3637

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/933,229

Applicant(s)

HAREL, KENNETH N.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*The changes in the first and second paragraph on page 3 are not entered as the changes suggested are exactly the same as the material currently in the specification. It is unclear what applicant is trying to change.*

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 6 "screw and ridge means" is indefinite. Should it be "groove and ridge means"?

Last line "said ribs" is lacking antecedent basis.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-9, 12-13, 20, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al (6295776) in view of Peterson (2012203).

Kunz et al (figure 1) shows a protective drywall joint device having a rigid elongated core (12) of a predetermined width, generally planar longitudinal edges, outer and inner surface,

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the core having an arcuate central portion in cross-section, a paper cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond at least one of said longitudinal edges to form at least one flexible flap (the edge of the cover which extends beyond the core) having an outwardly facing and an inwardly facing surface, the core being galvanized steel (col 3 line 22), the core being configured with a curved lengthwise cross-section (14) which has a generally convex outer surface and a concave inner surface, the flap having perforations (col 4 lines 51-55) extending therethrough throughout the length for flow of joint compound from one side to the other, the perforation being at least 1/64 of an inch ( $1/64 = .015625$ ).

Kunz et al does not show the flap having lengthwise grooves with ridges interposed therebetween, perforations formed along the grooves.

Peterson (figure 1) shows a cover having lengthwise grooves (5) and ridges (7) on a flap of a cover to impart flexibility to the cover to compensate for the plaster shrinkage and expansion, perforations formed along the grooves to allow compound to connect the interior and outer surfaces.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having lengthwise grooves with ridges interposed therebetween, perforations formed along the grooves because it would enable the cover to compensate for expansion and shrinkage in the plaster and a better attachment of the cover to a wall as taught by Peterson.

Per claim 9, Kunz et al as modified by Peterson shows all the claimed limitations except for the cover being constructed of at least three layers. Kunz et al discloses the paper being conventional GSM Sand Back stock paper.

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Applicant's disclosure page 10 lines 11 to page 11 line 3 discloses any conventional stiff paper will suffice for the invention including paper with at least three layers.

It would have been obvious to one having ordinary skill in the art at the time of the invention to show Kunz et al's paper having three layers because the examiner takes Official Notice of the equivalence of paper with at least three layers and the conventional GSM stock paper for their use in the drywall trim devices art and the selection of any of these known equivalents to cover the edge of the drywall corner would be within the level of ordinary skill in the art.

Per claim 32, Kunz et al as modified shows all the claimed limitations. Kunz et al as modified thus inherently can function to be placed/used as claimed.

3. Claims 4, 21-27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Peterson(2012203) as applied to claim 1 above and further in view of Bergin (5544463).

Kunz et al as modified by Peterson shows all the claimed limitations except for the core being made of plastic.

Bergin ( col 3 lines 39-43) discloses a corner bead made of either plastic or metal.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al's modified structure to show the core being made of plastic because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Per claims 21-24, 29 Kunz et al as modified shows all the claimed structures. The claimed method steps of making a drywall joint strip device would have been the obvious method steps of making Kunz et al's modified structures.

Per claims 25-26, Kunz et al as by Peterson and Bergin shows all the claimed limitations except for the core being formed by passing the core through an extrusion die.

Applicant's disclosure page 10 lines 5-7 discloses the method of forming a core using casting, molding, extruding, or roller-forming being well-known in the art.

It would have been obvious to one having ordinary skill in the art to at the time of the invention to modify Kunz et al's modified structures to show the core being formed by extrusion die because using an extrusion die to form a core is a well-known process in the art for forming a core as disclosed by applicant.

Kunz et al as modified by Peterson, Bergin and applicant's disclosure shows all the claimed structures. The claimed method steps of making a drywall joint strip device would have been the obvious method steps of making Kunz et al' modified structures.

Per claim 27, Kunz et al (col 3 lines 48-48) discloses the process of bonding the cover to the core by hot melt adhesive ( per page 11 lines 4-5 of applicant's disclosure, the adhesive is the same as the glue).

4. Claims 1, 10-11, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy (re34547).

Kunz et al (figure 1) shows a protective drywall joint device having a rigid elongated core (12) of a predetermined width, longitudinal edges, outer and inner surface, a paper cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond at least one

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of said longitudinal edges to from at least one flexible flap ( the edge of the cover which extends beyond the core), a plurality of perforations on the flaps spaced equidistant on the outer surface.

Kunz et al does not show the flap having at least three/four grooves lengthwise and four ridges interposed therebetween, the flaps having perforations spaced equidistant along the grooves.

Weldy (col 3 lines 37-40) discloses a plurality of perforations(26, figure 1) spaced equidistant along the grooves, a plurality of grooves lengthwise and ridges interposed therebetween to allow for strong engagement with a plaster material/mud ( col 3 lines 49-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having at least three/four grooves lengthwise and four ridges interposed therebetween, the flaps having perforations spaced equidistant along the grooves because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

Per claim 30, Kunz et al as modified by Weldy shows all the claimed limitations except for the grooves being spaced  $1/8^{\text{th}}$  of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least  $1/64^{\text{th}}$  of an inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to show the grooves being spaced  $1/8^{\text{th}}$  of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least  $1/64^{\text{th}}$  of an inch because it would have been an obvious matter of design choice to show the grooves being spaced  $1/8^{\text{th}}$  of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least  $1/64^{\text{th}}$  of an inch since such a modification would have involved a mere change in the size

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of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

5. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy(re34547).

Kunz et al (figure 1) shows a protective drywall joint device having a relatively rigid elongated core (12) formed with angular flanges (figure 3, the intersection of the planar (16 and the curving part (12)) terminating in longitudinal edges (figure 1, at 18), the core having a convex outer surface and a concave inner surface, cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond said longitudinal edges to form flexible flaps ( the edge of the cover which extends beyond the core), each cover having an outwardly facing surface and an inwardly facing surface, a plurality of perforations on the flaps to provide for the communication of uncured joint compound between the inner and outer surface, the compound when dried inherently would form compound posts.

Kunz et al does not show the flap having elongated grooves lengthwise and ridges disposed in alternating fashion along the outwardly facing surface, the flaps having perforations along the grooves.

Weldy (col 3 lines 37-40) discloses a plurality of perforations (26, figure 1) along the grooves, a plurality of grooves lengthwise and ridges disposed in alternating fashion along at the outwardly facing surface to allow for strong engagement with a plaster material/mud ( col 3 lines 49-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having elongated grooves lengthwise and ridges



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disposed in alternating fashion along the outwardly facing surface, the flaps having perforations along the grooves because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

6. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy(re34547).

Kunz et al (figure 1) shows a drywall joint assembly strip device having an elongated core/core means (12), a cover/cover means (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond said longitudinal edges to form at least one flexible flaps ( the edge of the cover which extends beyond the core), each cover having an outwardly facing surface and an inwardly facing surface, a plurality of perforations/communication means on the flaps to provide for the communication of uncured joint compound between the inner and outer surface, the compound when dried inherently would form compound posts.

Kunz et al does not show the flap having compound directing means/moisture-directing means, longitudinal rib means/reinforcing means, and the communication means being formed along the moisture directing means.

Weldy (col 3 lines 37-40) discloses a plurality of grooves/compound directing means/moisture directing means and ridges/rib/reinforcing means at the outwardly facing surface to allow for strong engagement with a plaster material/mud ( col 3 lines 49-55), the grooves/communicating means forming along the moisture directing means.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having compound directing means/moisture directing means, longitudinal rib/reinforcing means, the communicating means formed along the

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moisture directing means because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergin (5544463) in view of Rennich et al (5613335).

Bergin (figure 4) shows a protective drywall joint strip device having a rigid elongated core (6, col 4 line 6) having an inner and outer surface, a cover (2) bonded to the core and configured to project laterally beyond at least one of the longitudinal edges to form at least one flexible flap, the flap having elongated, lengthwise grooves (figure 4, the groove formed by ridges 9, and the grooves formed by ridges 2) with ridges interposed therebetween.

Bergin does not show the cover being constructed of fibers covered with a thin film of strengthening material.

Rennich et al discloses a cover (4) constructed of fibers covered with a thin film of strengthening material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Bergin's cover to show the cover being constructed of fibers covered with a thin film of strengthening material because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

#### ***Response to Arguments***

8. Applicant's arguments filed 7/29/02 to claims 1-27,29-30 have been fully considered but they are not persuasive.

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With respect to applicant's arguments that there are no motivation to modify Kunz with Peterson to show the flap having lengthwise grooves with ridges interposed therebetween and perforations along the grooves, examiner respectfully disagrees. As pointed out in the rejection above, the motivation for modifying Kunz with Peterson's grooves and ridges, and perforations is so that the cover of Kunz would be able to compensate for expansion and shrinkage in the plaster and better attachment of the cover to the wall. This added benefit and motivation is taught by Peterson as shown above. The combination of the references Kunz and Peterson to modify Kunz with Peterson is thus motivated and encouraged to enhance the teaching of Kunz. The argument is thus moot.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The argument is thus moot.

10. With respect to applicant's argument about the reference Weldy that the reference does not enable Kunz to meet the claimed limitations, examiner respectfully disagrees. As pointed out in the rejection above, Weldy shows the features of perforations spaced equidistant along the grooves, the grooves having ridges interposed therebetween for strong engagement with a plaster material. The motivation to modify Kunz with Weldy would be to enable strong engagement with a plaster material as taught by Weldy. The motivation is thus encouraged. Kunz as modified by Weldy certainly shows all the claimed limitations. With respect to applicant argument about the striations could not be used as anchoring feature, examiner respectfully

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disagreed as the striations would certainly enhance the anchoring features of Kunz. The argument is thus moot.

11. With respect to applicant's argument about Bergin reference not enabling the Kunz reference to meet the claimed limitations, examiner respectfully disagrees. Kunz as modified by Peterson does not show the bead being made of plastic or metal. Bergin shows the bead being made of plastic or metal. The modification of Kunz's modified reference with Bergin thus would show the claimed limitations. The argument is thus moot.

12. With respect to applicant's arguments about the method claims, Kunz as modified by Peterson and Bergin shows all the claimed limitations. The claimed method steps would have been the obvious method steps of making Kunz et al's modified structures. With respect to applicant's argument that the modification of Kunz with Peterson does not show multiple grooves. Examiner respectfully disagrees. As shown in the rejection above, Kunz as modified by Peterson shows multiple grooves. With respect to applicant's argument that there is no motivation to sand a strip and groove the a strip also, examiner respectfully points out that the motivation of having a sand strip with groove is stated in the rejection above. With respect to applicant's argument that the step of sanding substituted by the step of forming grooves and ribs, examiner respectfully points out that the modified structure encourage that both the step of sanding and the step of forming grooves and ribs be performed. The steps performed by Kunz's modified structures thus teach applicant's claimed method steps. The arguments are thus moot.

13. With respect to applicant's argument about claim 30, examiner respectfully points to the rejection above which clearly states the motivation for modification to show the claimed limitations. The argument is thus moot.

*Conclusion*

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different trim device and method of applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A  
November 27, 2002

PA

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read "Lanna Mai", with a long horizontal stroke extending to the right.